

REMARKS

Claim 1 has been amended to recited an upper limit for the water content based on the water content in Example 1 on page 34 in the application. Claim 20 has been added depending on claim 13 and reciting a water content based on the water content in Example 1 on page 34 in the application. Claim 21 has been added essentially corresponding to original claim 2 in independent form. Claims 22 and 23 have been added corresponding to claims 14 and 15, respectively, except for depending on claim 21.

Entry of the above amendment is respectfully requested.

Anticipation Rejection over Kuroya et al

On page 2 of the Office Action, in paragraph 2, claims 1 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuroya et al (JP 62-111918).

In response, Applicant notes initially that claim 1 has been amended to recite that the water content is from 5 to 18.975 mass%.

In contrast, the abstract of JP '918 teaches a lower limit of 20 wt% for the water content.

Thus, the invention as recited in the amended claims is not anticipated by JP '918.

Further, it is noted that the "USE/ADVANTAGE" section of the English language abstract of JP '918 provided by the Examiner discloses that "[b]ecause of the richness of the water content, coolness is kept for a long time and the effect of percutaneous drug is maintained." Because one would have wanted to keep coolness for a long time, and because one would have wanted to maintain the effect of percutaneous drug, one would not have reduced the

water content in JP '918 below 20 wt%, since the richness of the water content is responsible for those effects. Accordingly, JP '918 does not even suggest the invention as recited in the amended claims and thus does not even render it obvious.

In view of the above, Applicant submits that the invention as recited in the amended claims is not anticipated by (or obvious over) JP '918, and withdrawal of this rejection is respectfully requested.

Anticipation Rejection over Donati et al

On page 2 of the Office Action, in paragraph 3, claims 1, 3-5, 7-8, 10-11, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Donati et al (EP 1046395).

In response, Applicant notes initially that claim 1 has been amended to recite that the water content is from 5 to 18.975 mass%.

In contrast, the example on page 4 of Donati et al includes a water content 29.73%.

Thus, Donati et al does not anticipate the invention as recited in the amended claims.

Further, Donati et al does not even suggest a water content in the range of 5 to 18.975 mass%, so the invention as recited in the amended claims is not even obvious from Donati et al.

In view of the above, Applicant submits that the invention as recited in the amended claims is not anticipated by (or obvious over) Donati et al, and withdrawal of this rejection is respectfully requested.

Obviousness Rejection over Donati et al in view of Sato et al

On page 3 of the Office Action, in paragraph 6, claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donati et al (EP 1046395) in view of Sato et al (US 4,386,120).

In response, Applicant submits that one of ordinary skill in the art would not have been motivated to make the combination of references proposed by the Examiner.

In particular, Applicant submits that the viscosity of 50-700 c.p.s. is disclosed in Sato et al in connection with the spraying of an aqueous solution of the polyacrylic acid salt onto a powder of polyacrylic acid salt. Since the sodium polyacrylate in Donati is not sprayed, one of ordinary skill in the art considering Donati would not have been motivated to use a viscosity specifically based on spraying.

Also, Applicant submits that it seems that the viscosity 50-700 c.p.s. of polyacrylic acid salt solution is described in Sato et al only as a range appropriate for the purpose of spraying the polyacrylic acid solution onto polyacrylic acid salt powder to form water-soluble polyacrylic acid salt granules. That is, the Sato reference does not describe about plasters, and its technical field is not relevant to the polyacrylic acid salt described in EP 1046395. Therefore, Applicant submits that one skilled in the art would not have been easily motivated to combine the two references.

For at least the above reasons, Applicant submits that the present claims (including new claim 21 corresponding essentially to claim 2 prior to the above amendment of claim 2, as well

as new claims 22 and 23 depending on claim 21) are not obvious over Donati et al in view of Sato et al, and thus withdrawal of this rejection is respectfully requested.

Obviousness Rejection over Donati et al in view of Bernstein and LaHann

On page 4 of the Office Action, in paragraph 7, claims 12, 15, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donati et al (EP 1046395) in view of Bernstein (EP 95512A) and LaHann (US 4,313,958).

In response, Applicant submits initially that Bernstein and LaHann do not make up for the deficiency of Donati with respect to the water content of the present invention as discussed above, so the combination of Donati with Bernstein and LaHann neither teaches nor suggests the claimed invention.

Further, Applicant submits that simply because capsaicin is a well known pharmaceutically active ingredient, such does not mean that one would have substituted it in place of diclofenac in Donati. Indeed, Applicant submits that there is no indication in the cited art that capsaicin would be interchangeable with diclofenac in a plaster such as that disclosed in Donati, and thus one would not have even made the combination proposed by the Examiner.

For at least the above reasons, Applicant submits that the present invention is not obvious over Donati et al in view of Bernstein and LaHann, and thus withdrawal of this rejection is respectfully requested.

Obviousness Rejection over Donati et al in view of Yamazaki et al

On page 5 of the Office Action, in paragraph 8, claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donati et al (EP 1046395) in view of Yamazaki et al (JP 06145049).

In response, Applicant submits that Yamazaki does not make up for the deficiency of Donati with respect to the water content of the present invention as discussed above, so the combination of Donati with Yamazaki neither teaches nor suggests the claimed invention.

Thus, Applicant submits that the present invention is not obvious over Donati et al in view of Yamazaki et al, and withdrawal of this rejection is respectfully requested.

Obviousness Rejection of Claim 13 over Donati et al

On page 6 of the Office Action, in paragraph 9, claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donati et al (EP 1046395).

In response, Applicant notes initially that claim 13 of the present application recites a process including a step of mixing components such as (meth)acrylic acid-base polymer so that the water concentration based on the total weight may be in a range of 50 % or more and a subsequent step of adding the other components thereto to thereby relatively reduce the water concentration of the obtained adhesive composition for a dermal patch.

In the first step of adjusting the water concentration to be 50 % or more, a polymer can be dissolved in a short time, to thereby make the reaction system uniform.

If polyhydric alcohol is added thereto, the polymer does not get aggregated. Therefore, an adhesive for dermal patch having good adhesion can be prepared.

The procedures in the preparation process of the hydro gel mixture described in EP 1046395 are different from those of claim 13 in that the whole amount of polymer (A) is added to be dissolved in the solution before addition of the whole amount of polyhydric alcohol in the present invention, while a thickening agent (sodium polyacrylate) is added even after addition of polyhydric alcohol.

That is, the steps of the present invention include consideration of compatibility between the polymer and the polyhydric alcohol, which is not suggested in EP 1046395.

Further, it is submitted that Donati intends that the disclosed steps be carried out in a particular order, since paragraph [0027] discloses that the mixing phase is "in particular" carried out in the disclosed stages. In view of this teaching that the disclosed steps be carried out in a particular order, one of ordinary skill in the art considering Donati would not have altered the sequence of steps.

With respect to new claim 20, Applicant submits that this claim is additionally unobvious because Donati et al does not suggest a water content in the range of 5 to 18.975 mass%.

Accordingly, Applicant submits that the present invention is not obvious over Donati et al, and withdrawal of this rejection is respectfully requested.

Conclusion

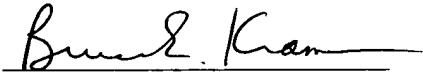
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/532,873

Attorney Docket No. Q72768

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: March 12, 2007